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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/875,547 | 06/05/2001 | Dan Kikinis | 004688.P027 | 6896 |
| 33448 | 7590 | 04/07/2005 | EXAMINER | |
| ROBERT J. DEPK LEWIS T. STEADMAN HOLLAND & KNIGHT LLC 131 SOUTH DEARBORN 30TH FLOOR CHICAGO, IL 60603 | | | LAYE, JADE O | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2614 | |
| DATE MAILED: 04/07/2005 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/875,547 | KIKINIS, DAN | |
| | Examiner | Art Unit | |
| | Jade O. Laye | 2614 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 05 June 2001.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-21 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-21 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 05 June 2001 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>6/5/01, 7/19/01, 3/22/01</u> | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Information Disclosure Statement***

1 The information disclosure statements (IDS) submitted on 6/05/01, 7/19/01, and 3/22/01 are in compliance with the provisions of 37 CFR 1.97. Accordingly, each has been considered by the examiner.

Drawings

2. The drawings are objected to because Figures 2 and 3 are not descriptively labeled. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. The abstract of the disclosure is objected to because of the phrase "...A set top box..." "A" should not be capitalized.

Correction is required. See MPEP § 608.01(b).

4. The disclosure is objected to because of the following informalities:

- Home entertainment system 10 is not shown in Figure 1. (Discussed throughout Specification) The Examiner assumes Figure 1 is Home entertainment system 10. However, the drawing should be labeled accordingly.
- Various components of Figure 3 are incorrectly referred to as 402, 405, 406, and 407. (Page 10 of Spec.) These components are referred to in the drawings as 302, 305, etc., respectively.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 2614

5. Claims 1, 3- 8, 10-15, and 17-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Hassell et al. (US Pat. Pub. No. 2004/0128685).

As to claim 1, Hassell discloses an entertainment system comprising a set top box (STB) capable of displaying an electronic programming guide (EPG). In response to the user pushing a “transfer” button on the remote, a program and related data can be transferred from a first storage device located in the STB to another removable storage device located within the STB or separate from the STB. (Pars. [0006, 0008, 0019, 0020, 0021, & 0081]). Therefore, Hassell et al anticipate each and every limitation of claim 1.

Claims 8 and 15 correspond to the method claim 1. Accordingly, each is analyzed and rejected as previously discussed.

As to claim 3, Hassell further teaches the use of a remote, wherein the transfer is initiated by the user pressing the “transfer” button. (Par. [0081]). Therefore, Hassell et al anticipate each and every element of claim 3.

Claims 10 and 17 correspond to the method claim 3. Accordingly, each is analyzed and rejected as previously discussed.

As to claim 4, Hassell further teaches that in response to the single selection of the transfer button, the system transfers programs and related data from the removable storage medium to another storage device (i.e., volume) within the STB. (Pars. [0037, 0039, 0040, 0081]). Therefore, Hassell et al anticipate each and every limitation of claim 4.

Claims 11, and 18 correspond to the method claim 4. Accordingly, each is analyzed and rejected as previously discussed.

As to claim 5, Hassell further teaches the system maintains a media library contained within the storage device, which can track/update the directory according to the viewers preferences. (Par. [0085 & 0086]). Therefore, Hassell et al anticipate each and every limitation of claim 5.

Claims 12 and 19 correspond to the method claim 5. Accordingly, each is analyzed and rejected as previously discussed.

As to claim 6, Hassell further discloses that upon selecting a program that has been transferred to the removable storage device, the STB will prompt the user to insert the removable storage device if its not presently inserted in the STB. (Pars. [0089 & 0109]). Therefore, Hassell et al anticipate each and every limitation of claim 6.

Claims 13 and 20 correspond to the method claim 6. Accordingly, each is analyzed and rejected as previously discussed.

As to claim 7, Hassell further teaches the removable storage device can be a DVD-RAM. (Par. [0008]). Therefore, Hassell et al anticipate each and every limitation of claim 7.

Claims 14 and 21 correspond to the method claim 7. Accordingly, each is analyzed and rejected as previously discussed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 2, 9, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hassell et al.

Applicant's claim 2 recites the method of claim 1, wherein the single selection includes a single pressing of a selected portion on a control panel of the STB. As discussed above, Hassell et al disclose all limitations of claim 1, and further teach the user input interface can be a wireless remote, keyboard, etc. or any other suitable input device. (Par. [0025]). Although not specifically disclosed, this teaching does encompass the limitation of claim 2. Therefore, it would have been obvious to one of ordinary skill in this art at the time of applicant's invention to modify this teaching of Hassell in order to provide a system whereby the user interface was the STB itself, thus providing an alternative method of user interaction.

Claims 9 and 16 correspond to the method claim 2. Accordingly, each is analyzed and rejected as previously discussed.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Russo (US Pat. No. 5,619,247) discloses a STB capable of storing programs on a removable medium.
- b. Nakatsuyama (US Pat. Pub. No. 2004/0123333) discloses a STB capable of storing programs on a removable medium.
- c. Nishioka et al (US Pat. Pub. No. 2004/0168198) disclose a STB capable of storing programs on a removable medium.
- d. Cooper et al (US Pat. Pub. No. 2005/0039219) disclose a STB capable of storing programs on a removable medium.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jade O. Laye whose telephone number is (571) 272-7303. The examiner can normally be reached on Mon. 7:30am-4, Tues. 7:30-2, W-Fri. 7:30-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you

Art Unit: 2614

have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner's Initials JL
March 30, 2005.



NGOC-YEN VU
PRIMARY EXAMINER